

Remarks

The following remarks are submitted in response to the final Office Action mailed 3 June 2003. No claims have been cancelled. Therefore, claims 7-19 are pending in the present application.

The 35 U.S.C. §103 Rejection

The Examiner rejected claims 7-19 under 35 U.S.C. §103(a) as being unpatentable over Long in view of background invention of Chow or Chow (newly cited U.S. Patent No. 5,644,629). It is believed that Chow has been previously cited and is not a "newly cited" reference.

The Examiner continues to assert that Long teaches all the subject matter of the claimed invention with the exception of "hanging up communication." However, the Examiner alleges that Chow teaches "a provision of Quick hang up" and that it would have been obvious to use the quick hang up of Chow in the network of Long for the purpose of terminating the unwanted list numbers.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations. *See* M.P.E.P. § 2143.

As previously submitted, there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify Long with Chow to provide the present invention.

For example, Long teaches something entirely different than a hanging up function. As stated in Long, if a call is to be ignored, a display device receives an appropriate indication alerting the customer to ignore the phone. *See* Long, column 7, lines 13-30. From the disclosure

provided in Long, the ringing continues until the calling party terminates the call. No "hanging up" operation is taught by Long. Further, Long teaches that the disclosed device can be programmed to either not turn on the ring function of the phone being called or not place such phone in an off-hook state when an unauthorized caller ID is detected. According to Long "[i]f the called customer does not pick up the receiver, the ringing signal continues until the calling party hangs up their telephone which terminates the call." Long, column 6, lines 13-16 (emphasis added). In other words, the party receiving the incoming call does not hang up on the caller. Instead, the calling party terminates their own phone call by hanging up. This teaching of Long is completely the opposite of the present invention, where the telephone personal communications system being called hangs up on the caller if the caller's access to the system is unauthorized.

In Chow (column 2, lines 4-13), hang up is accomplished by routing a call to an external answering machine which answers the call, after which, an off-hook signal is detected, waits for a second or so, and then breaks the connection to the incoming telephone lines.

While Chow describes a provision for hang up, one would not be motivated to modify Long with the teachings of Chow when making the modification would change the principle of operation of Long. Applicant continues to maintain that if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. See M.P.E.P. § 2143.01 This is clearly the case when attempting to modify Long with Chow. Whether Long describes an answering machine or not (as discussed in the Examiner's comments on Applicants' argument), does not appear relevant to determining whether the principle of operation is changed by the modification.

As stated above, Long teaches that the party receiving the incoming call does not hang up on the caller. Instead, the calling party terminates their own phone call by hanging up. This teaching of Long is completely opposite of the use of a hang up function and one would not modify Long with such a hang up function as described in Chow when making the modification would completely change the principle of operation of Long.

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Serial No. 09/400,607

Confirmation No. 3600

COMPUTER-BASED MULTIFUNCTION PERSONAL COMMUNICATION SYSTEM WITH CALLER ID

For at least the above reasons, claims 7, 16, and 19 are not obvious over the cited references, Long and Chow.

Claims 8-15 and 17-18 which depend from either independent claim 7 or 16, are not obvious over Long and Chow for at least the same reasons as presented above for independent claims 7, 16, and 19.

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Summary

It is respectfully submitted that the pending claims are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted for
CASWELL et al.

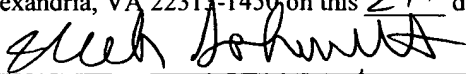
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29 Aug 2003
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CERTIFICATE UNDER 37 CFR §1.8:

The undersigned hereby certifies that the Transmittal Letter and the paper(s) and/or fee(s), as described hereinabove, are being deposited with the United States Postal Service as first class mail, in an envelope addressed to: Assistant Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 29th day of August, 2003.

By: 
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